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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,969	01/18/2000	Brian E. Farley	VNUS-53427	9082

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EXAMINER

RODRIGUEZ, CRIS LOIREN

[REDACTED]  
ART UNIT            PAPER NUMBER

3763

DATE MAILED: 05/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/483,969	FARLEY ET AL.	
	Examiner	Art Unit	
	Cris L. Rodriguez	3763	

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 08 January 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 34-82 is/are pending in the application.

4a) Of the above claim(s) 35,37,44-47,54,56-59,62-64,69-71,75 and 76 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 34,36,38-43,48-53,55,60,61,65-68,72-74,77 and 78 is/are rejected.

7) Claim(s) 79-82 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 18 January 2000 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> .	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

*Election/Restrictions*

1. Applicant's election with traverse of species D)figures 11-15, claims 34, 36, 38-43, 48-53,55,60,61,65-68,72-74, and 77-82 in Paper No. 6 is acknowledged. The traversal is on the ground(s) that species D and E are similar embodiments and should have been grouped together since they have commonality of operation, function and effect between them. This is found persuasive. Therefore, *the election of species should have been as follows*: species A)figures 6-8, B)figure 9, C)figure 10, D)figures 11-15 and 19, E)figure 20, and F)figure 25.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 35, 37, 44-47, 54, 56-59, 62-64, 69-71, 75, and 76 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

*Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 34, 36, 38, 48, and 53 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 10, and 12-14 of U.S. Patent No. 6,139,527. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claims a catheter having extendable members, and electrodes located at the extendable members.

*Drawings*

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "76" as set forth on page 18 lines 12-13; reference numeral "35" as asset forth on page 20 line 31. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Specification*

6. The disclosure is objected to because of the following informalities: on page 10 line 20 sets forth a range of "250 KHz to 350mHZ". Is this range correct? Appropriate correction is required.

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 34, 38-40, 43, 48, 49, 52, 53, 55, 60, 61, and 65 are rejected under 35 U.S.C. 102(e) as being anticipated by Behl et al (US 5,709,224).

Behl discloses a catheter (figs 1-4C, and 7) having a working end 16, and at least two electrodes 24 to cause shrinkage of a blood vessel.

9. Claims 68, 72-74, 77, 78 are rejected under 35 U.S.C. 102(e) as being anticipated by Fleischman (US 5,885,278).

Fleischman discloses a catheter having a working end 22, and at least four exposed, electrically conductive surfaces 20(1), in fig. 9, located at the distal end of the catheter, a plurality of electrically conductive lines (figs 10-11A) electrically connected to the exposed surfaces.

#### *Claim Rejections - 35 USC § 103*

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 36, 50 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behl in view of Fleischman.

Behl discloses the invention substantially as claimed. However, Behl fails to disclose a temperature sensor located on one of the at least two electrodes.

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Fleischman teaches an ablation catheter (figs 7-11A) having electrodes 34, and the electrodes having temperature sensors 68. Given the teachings, it would have been obvious to one having ordinary skill in the art at the time the invention was made include Fleischman's temperature sensors in Behl's electrodes. Doing so would have measure the temperature during the medical procedure.

*Allowable Subject Matter*

12. Claims 41, 42, 51, 67, and 79-82 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cris L. Rodriguez whose telephone number is (703) 308-2194. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

May 16, 2002

  
Cris L. Rodriguez  
Examiner  
Art Unit 3763

  
BRIAN L. CASLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700